

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

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Amendment under 37 CFR § 1.111 filed January 8, 2007

**REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claims 36-39 have been added. Claim 36 is previous claim 12 reintroduced. Claims 37-39 recite the limitations of claims 31, 34 and 35, respectively, but are dependent on claim 36. Applicants submit that these claims do not introduce new matter. An early notice to that effect is earnestly solicited.

Claims 24-35 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have amended the “whereby” clause of claim 24 in a manner that is believed to clarify the situation. Applicants submit that claim 24 and the other rejected claims, which depend on claim 24, are definite. An early notice to that effect is earnestly solicited.

Claims 24-35 were rejected under 35 USC § 112, first paragraph, as claiming new matter. According to the Examiner, the specification does not contain any express support for the “whereby” clause of claim 24, which is incorporated by reference into the other rejected claims. Applicants respectfully disagree.

The Examiner says at the top of page 3 of the Office Action that the “whereby” clause merely states an elementary fact, namely that “a backing by itself has less tear resistance than a tape formed from the same backing which is also coated with an adhesive layer.” Respectfully, this is *not* what the previous “whereby” clause said, nor what the present “whereby” clause says. They both say, in no uncertain terms, that the backing “*would tear*” but for the presence of the self-adhesive composition. This is a different thing altogether from merely saying that the backing is “less resistant to tearing” than the backing coated with self-adhesive. “Less resistant

to tearing” encompasses the possibility that the backing does not tear. However, it is important that the Examiner understand that what Applicants have required in claim 24 is that the backing *would tear* if not for the presence of the self-adhesive composition, but, because the self-adhesive composition is present, the backing does not actually tear when the inventive tape is debonded.

The first portion of the current “whereby” clause reads as follows:

“the backing is selected such that the backing *would tear* if the backing was pulled by itself without the self-adhesive composition with the same force necessary to remove said adhesive tape from said substrate...”

Clearly, this means that if you had a piece of the backing by itself (without the self-adhesive composition applied to either side) and you pulled that adhesiveless backing with the same force that would be needed to remove the inventive adhesive tape from a substrate, then the adhesiveless backing would tear. In other words, without the self-adhesive composition applied to backing, the backing tears when subjected to the force needed to remove the adhesive tape from the substrate.

The second portion of the current “whereby” clause reads as follows:

“...but the backing does not tear when said adhesive tape is removed from said substrate.”

Clearly, this means exactly what it says, i.e., the backing does not tear when the adhesive tape is removed from the substrate. In other words, whereas the backing would tear if pulled by itself, the backing does not tear when contained in the adhesive tape that includes the self-adhesive composition as claimed.

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This is exactly what is shown in instant Example 1. The adhesive tapes of Samples 3.009 and 3.010 both *tore* before the adhesive tape could be removed from the substrate. The tearing was not only of the adhesive, but of the backings as well. Consequently, the backings of Samples 3.009 and 3.010 cannot themselves be strong enough to resist the force necessary to remove the adhesive tape from the substrate. If they were, then the adhesive tapes would not have torn. On the other hand, if the backings tore when combined with the adhesive, the backings would tear by themselves. Consequently, the backings of Samples 3.009 and 3.010 satisfy test 1. The adhesiveless backings would tear if subjected to the same force necessary to remove the adhesive tapes from substrates to which they were adhered.

The adhesive tapes of Samples 3.001A and 3.006 have the *same backings* as Samples 3.009 and 3.010, respectively, i.e., weak, tearable backings. Yet, the adhesive tapes of Samples 3.001A and 3.006 did *not* tear. Consequently, Samples 3.001A and 3.006 satisfy test 2. The backings of these adhesive tapes did not tear when the adhesive tape was removed from a substrate to which it was adhered.

In other words, Samples 3.001A and 3.006 contain backings that:

- (1) would tear in the absence of adhesive under the force necessary to remove the adhesive tape from the substrate, but
- (2) do not tear in the presence of an appropriate adhesive.

This is all that is covered by the “whereby” clause of claims 24-35, and this is demonstrated in the original examples. Consequently, claims 24-35 do not introduce new matter, but, instead, are amply supported by the original disclosure.

Further, exactly this beneficial combination of a tearable backing and an appropriate adhesive is discussed in the paragraph in the instant specification at page 4, lines 12-21. There, it

is taught that it is only the combination of

(1) highly stretchable pressure-sensitive adhesive compositions of high tear strength  
with

(2) polymeric foams *which do not tear during the detachment process in combination with pressure-sensitive adhesive compositions* employed in accordance with the invention

that makes it possible to realize very thin-layer and yet highly conformative self-adhesive tapes which can be redetached without residue and *without destruction* by stretching. Clearly, it is taught that the polymer foams, i.e., the backings, are those which do not tear during the detachment process when combined with the pressure-sensitive adhesive compositions required by the claims. This clearly implies that if not for the fact that the polymeric foams were combined with the pressure-sensitive adhesives, then the polymeric foams would tear.

The "whereby" clause of claims 24-35 is amply supported by the written description and by working examples, and, therefore, does not claim new matter. Clearly, Applicants had possession at the time of filing of exactly what is now claimed. An early notice that this rejection has, therefore, been reconsidered and withdrawn is earnestly solicited.

Claims 24-35 were rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over Bries et al. ("Bries"), WO 95/06691. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

**1. Bries does not teach or suggest embodiments meeting the “whereby” clause of claims 24-35.**

With respect to claims 24-35, Applicants refer again to the discussion above concerning the Examiner’s misreading of the “whereby” clause of claim 24. This “whereby” clause embodies two tests that must be satisfied in order to read on the rejected claims:

- (1) the backing *would tear* if pulled by itself (backing alone) with the same force necessary to remove the adhesive tape from the substrate; *and*
- (2) the backing *does not tear* when the adhesive tape (backing + adhesive) is removed from the substrate.

Applicants have repeatedly requested that the Examiner point to specific portions of Bries by page and line number where embodiments meeting these two tests are taught or suggested. The Examiner has so far ignored Applicants’ requests, now commenting that he “has little to add.” Respectfully, the Examiner must deal with each and every limitation in claims 24-35 and show where in Bries they are specifically taught or, if they are not specifically taught, why they would have been obvious to a person having ordinary skill in the art given what Bries does teach. In the absence of such explanation, Applicants respectfully submit that the Examiner cannot have made out a *prima facie* case of either anticipation or obviousness as to claims 24-35. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as to those claims.

**2. Bries does not teach or suggest the use of a backing having a thickness less than 760 microns.**

Applicants respectfully submit that this rejection should be withdrawn as to *all* claims, including new claims 36-39, because Bries teaches a minimum thickness limit of 30 mils = 760 microns, and the instant claims require a maximum thickness of 600 microns. The Examiner has read Bries as teaching the 760 micron minimum thickness only as a preferred limitation. However, Applicants respectfully submit that this is not how persons skilled in the art, including Bries, would view Bries' teachings. Bries does not contain any specific teaching or suggestion of a backing having a thickness less than about 30 mils.

Indeed, Bries clearly teaches away from the use of thicknesses less than 30 mils teaching problems even when thicknesses slightly above 30 mils are used. A person having ordinary skill in the art would not have been motivated by Bries to use foams having a thickness less than 30 mils.

In its 20 working examples, Bries' only disclosure is of adhesive tapes comprising backings having a thickness greater than 30 mils. Those working examples are summarized below:

BRIES' WORKING EXAMPLES	POLYMERIC FOAM THICKNESS	Adhesive Residue on Debonding?
1-7	31 mils (page 16, lines 12-13)	Yes, for Examples 1, 2, 6 and 7
8-14	Same foam from Examples 1-7 = 31 mils (page 19, lines 6-7) + 15 mil foam = 46 mils (for the multilayer foam)	Yes, for Examples 8, 9, 13 and 14
15-16	62.5 mils (page 21, line 7)	No
17-19	31.3 mils (page 23, line 5)	Yes, for Examples 17 and 19
20	62 mils (page 23, lines 16-17)	Results not shown

The data clearly show that problems are encountered using foam thicknesses slightly above 30 mils (Examples 1, 2, 6 and 7 using 31 mils) and even a good deal above 30 mils (Examples 8, 9, 13 and 14, using 46 mils.) In each of these examples, there was at least very slight adhesive residue remaining after debonding.

The data also clearly show that the best results are obtained with the thicker foam of Examples 15-16 (using 62.5 mils), where no adhesive residue remained upon debonding. A person having ordinary skill in the art would have been led by Bries' teachings away from the use of thinner backings, as presently claimed, towards the use of thicker backings in accordance with Bries' working examples, which show adhesive residue remains upon debonding in the case of thinner foams.

Finally, Applicants point out that there is support for Applicants' reading of Bries in a number of commonly owned documents, published after Bries, including some later works by the very same inventors. The Examiner will note that the inventors on Bries are James L. Bries and Michael D. Hamerski, and, further, that Bries is assigned to 3M.

U.S. Patent No. 6,410,135, issued on June 25, 2002, to the same inventors (Bries and Hamerski) and owned by the same assignee (3M), teaches the following at column 1, lines 45-53:

"PCT International Publication No. *WO 95/06691* discloses a removable foam adhesive tape comprising a backing including a layer of polymeric foam, and a layer of pressure-sensitive adhesive coated on at least one surface of the backing. The foam layer of the backing has *a thickness of about 30 to about 1000 mils*, and the backing has a lengthwise elongation at break of from about 50% to about 1200%, and a Young's modulus of less than about 2,400 psi."



U.S. Patent No. 6,541,089, issued on April 1, 2003, to inventor Hamerski and others, and also assigned to 3M, also teaches that the foam backing of WO 95/06691 has “a thickness of about 30 to about 1000 mils” at column 1, lines 44-52.

U.S. Patent No. 6,641,910, issued on November 4, 2003, to inventor Bries and others, and also assigned to 3M, also teaches that the foam backing of WO 95/06691 has “a thickness of about 30 to about 1000 mils” at column 1, lines 49-57.

U.S. Patent No. 6,821,619, issued on November 23, 2004, to both inventors Bries and Hamerski, and, again, also assigned to 3M, also teaches that the foam backing of WO 95/06691 has “a thickness of about 30 to about 1000 mils” at column 1, lines 49-57.

Finally, U.S. Patent No. 7,028,958, issued on April 18, 2006, to different inventors (Pitzen and Johansson), but also assigned to 3M, teaches the following at column 1, lines 49-57:

“U.S. Pat. No. 6,231,962 (Bries et al.) discloses a removable foam adhesive tape with a non-adhesive pull tab. The adhesive tape comprises a backing including a layer of polymeric foam and a layer of pressure-sensitive adhesive coated on at least one surface of the backing. The foam layer of the backing has *a thickness of about 30 to about 1000 mils*, and the backing has a lengthwise elongation at break of from about 50% to about 1200%, and a Young’s modulus of less than about 2,400 psi.”

U.S. Patent No. 6,231,962 appears to be the U.S. counterpart of WO 95/06691. Both U.S. Patent No. 6,231,962 and WO 95/06691 claim priority of USSN 08/114,500 filed on August 31, 1993.

Clearly, those skilled in the art, including the inventors themselves (Bries and Hamerski), the assignee (3M) and other skilled artisans at the same assignee (Pitzen and Johansson) viewed WO 95/06691 as teaching a minimum backing thickness of about 30 mils = 760 microns. As

discussed above, the remainder of WO 95/06691 clearly directs those skilled in the art towards the use of even thicker backings, and, therefore, away from the use of thinner backings as required by the instant claims.

In view of the foregoing, Applicants respectfully submit that WO 95/06691 does not anticipate or render obvious the instant claims. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

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Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
NORRIS McLAUGHLIN & MARCUS, P.A.

By 

Kurt G. Briscoe  
Attorney for Applicant(s)  
Reg. No. 33,141  
875 Third Avenue  
18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844

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